REMARKS

Claims 1-4, 6, 8-11, 13, 15-18 and 20-29, all the claims pending in the application, stand rejected.

Withdrawal of Finality

The Examiner has designated the rejection in this Office Action as being "final." The rejection includes newly added claims 27-29, which previously had not been examined by the Examiner. Moreover, the rejection is based upon a newly applied patent to Girardin (4,874,177). Applicant would submit that the designation of the rejection as being final is improper under applicable USPTO policy and should be withdrawn.

In particular, MPEP 7.07(h) provides that an RCE is proper where a submission is made after final rejection. The MPEP states that "a "submission" as used in 37 CFR 1.114 includes, but is not limited to, an information disclosure statement, an amendment to the written description, claims, or drawings, new arguments, or new evidence in support of patentability. See 37 CFR 1.114(c). The submission of an RCE entitles the Applicant to a first office action that is non-final so that examination can be continued, amendments made, interviews held and prosecution advanced. MPEP 7.07(h) further provides that the action immediately subsequent to the filing of an RCE with a submission and fee under 37 CFR 1.114 may be made final only if the conditions set forth in MPEP § 706.07(b) for making a first action final in a continuing application are met. Applicant would submit, that they are not met in this case.

In this case, the basis for making the rejection final is stated at page 7 of the Office Action to be "Applicants amendment necessitated new grounds of rejection presented in this Office Action." However, the filing of an RCE is specifically intended to enable entry of new claims or claims previously refused entry because they raised new issues. In this case, Applicants added new claims 27-29 in order to further define the invention over the prior art and to enable the conduct of an interview. The Examiner has thus admitted that new grounds of rejection are added but has improperly designated the rejection as final.

Applicant further notes that MPEP 706.07(b) - Final Rejection, When Proper on First Action - states that:

> The claims of a new application may be finally rejected in the first Office action in those situations where (A) the new application is a continuing application of, or a substitute for, an earlier application, and (B) all claims of the new application (1) are drawn to the same invention claimed in the earlier application, and (2) would have been properly finally rejected on the grounds and art of record in the next Office action if they had been entered in the earlier application....
>
> However, it would not be proper to make final a first Office action in a continuing or substitute application where that application contains material which was presented in the earlier application after final rejection or closing of prosecution but was denied entry because (A) new issues were raised that required further consideration and/or search, or (B) the issue of new matter was raised.
>
> A request for an interview prior to first action on a continuing or substitute application should ordinarily be granted.

Clearly, in the present case, the Applicant added new dependent claims that are directed to new and previously unclaimed subject matter. Should these claims have been presented in the previous final rejection, they would have been denied entry because, as stated by the Examiner in the present Office Action, they raised new issues. Given this position of the Examiner,

Applicant is entitled to have the claims examined, and to have an opportunity to further amend the claims on the basis of the Examiner's new rejection, and to have the claims fully prosecuted.

Claim Rejections - 35 U.S.C. § 103

Claims 1-4, 6, 8-11, 13, 15-18, 20, 22, 24-26 and 29 are rejected under 35 U.S.C. §103(a) as being unpatentable over Fongeallaz (5,186,460) in view of Filiczkowski (5,106,098) and Nakagawa et al (EP 0757917). This rejection is traversed for at least the following reasons.

Applicant notes that the Examiner has merely repeated the text of the rejection from the Office Actions dated July 21, 2004 and March 30, 2005 in finally rejecting the claims. The Examiner has not provided any further comments in the Response to Arguments at page 7 of the Office Action, since Applicant did not make any substantive argument.

Applicant does note with respect to claim 29 that the Examiner asserts that Filiczkowski's tracks have variable (grass or turf) and selectable (inner or outer) turf or soil conditions. Applicant submits that selecting inner or outer tracks, even if taught, is not a selection of turf or soil **conditions**, as supported by the disclosure at page 23, where turf conditions include "depth, hardness, roughness and the like" while soil conditions include "viscosity and the like"). Nothing of this sort is taught in Filiczkowski.

Claims 23 and 28 are rejected under 35 U.S.C. §103(a) as being unpatentable over Fongeallaz (5,186,460) in view of Filiczkowski (5,106,098) and Nakagawa et al (EP 0757917), and further in view of Ikeda et al (6,371,854). This rejection is traversed for the reasons given in the Amendment filed on October 6, 2003 and January 18, 2005. Moreover, with respect to new claim 28, the Examiner's comment that Ikeda teaches training of the running model and that such training would include training on one or more of the plural tracks is not supported by any disclosure and would involve the impermissible use of hindsight in view of the Applicant's own teachings.

Claim 27 is rejected under 35 U.S.C. §103(a) as being unpatentable over Fongeallaz (5,186,460) in view of Filiczkowski (5,106,098) and Nakagawa et al (EP 0757917), and

further in view of Girardin (4,874,177). This rejection is traversed for at least the following reasons.

The rejected claim depends from claim 1 and further states that "said physical running model is a selected one physical running model taken from a plurality of physical running models that differing [sic differ] on the basis of inherent ability parameters, said plurality of physical running models being displayed as list at least on the basis of ownership and said selected one physical running model being eligible for selection from said list according to the type of track."

The Examiner admits that Fongeallaz, Filiczkowski and Nakagawa fail to teach this feature. The Examiner identifies a newly applied reference to Girardin in the Abstract and Fig. 8 for this feature. The Examiner asserts that this allows a player to choose a horse that the player believes will have the best chance to win.

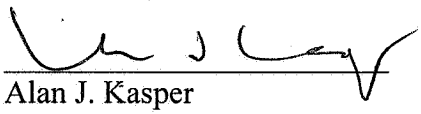
Applicant notes that the reference concerns a horse racing game in which two types of tracks are used, a dirt track 14 and a turf track 16. Also, Fig. 8 and Fig. 9A provide information about the individual horses and the track conditions, respectively. In support of the patentablity of the claim, Applicant respectfully submits that the display is not of the combination of a display of plural models by ownership and ability, along with type of track.

Further, claims 27-29 were added in order to permit filing of an RCE and to obtain a first non-final office action so that an interview could be held and patentable subject matter explored with the Examiner. Applicant respectfully submits that the designation of the present Office Action as final, notwithstanding the use of new references to reject the new claims, denied the Applicant this opportunity. Applicant respectfully requests that the finality be withdrawn, that a consideration of allowable subject matter be given, and that an interview be held in order to arrive at an agreement on such subject matter.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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